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09/992,091	11/16/2001	Mark Ireton	7916-005	9462

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EXAMINER

LE, UYEN T

ART UNIT	PAPER NUMBER
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2171

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DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/992,091

Applicant(s)

IRETON, MARK

Examiner

Uyen T. Le

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment to claim 8 is acknowledged. Consequently, rejection to claims 8-15 under 35 U.S.C. 112, second paragraph and objection to claim 8 are withdrawn.

2. Applicant's arguments filed 14 April 2004 have been fully considered but they are not persuasive.

Regarding claim 1, applicant argues that Rose "fails to provide a device remote from its media management system". In response, this limitation is not reflected in the claim language.

Applicant points to page 7, lines 16-17 of the specification and further argues that Rose "fails to provide a remote media device on which its content database can describe more media than resides on the media source". In response, again this limitation is not reflected in the claim language. Claims are interpreted in light of the specification but the specification cannot be read into the claims.

Regarding claim 8, applicant argues that Rose "fails to provide any disclosure regarding a device separate from the source that can manage relationships of the content on and off the player". In response, again, applicant argues limitations not reflected in the claim language.

Applicant further argues that Rose "fails to teach or describe a method for a remote device receiving user input changing the relationship of content on the remote

device and one or more content sources and upon connecting to a source, the remote media device controlling the execution of the relationship changes. In response, again applicant argues limitations not reflected in the claim language.

Regarding claim 16, applicant argues that Perkes "fails to teach or suggest a method for adding content to a media player that comprises a database, which media player can function remote from the media sources". In response, claim 16 does not recite a media player that comprises a database. It merely requires "determining if any content files in the list of content files do not exist on the player". Furthermore, the method of Perkes clearly allows a user to add content to a media player remote from media sources since the user purchases media sources over a network (see Figures 12, 13). The media player of Perkes clearly functions remote from the media sources since it operates in a media on demand framework (see Figure 14) and has to comprise a database since the user will purchase media sources that are not already in the player database.

Regarding claim 19, applicant arguments are incomprehensible. Note that claim 19 merely corresponds to a computer program product to perform the method of claim 8 or 16.

Applicant presents no further arguments regarding dependent claims except that they depend from allowable claims.

For all the reasons discussed above, rejection to all claims is maintained using the references of record, hereby repeated.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Rose et al (US 5,752,244).

Regarding claim 1, Rose discloses the claimed media player including a storage to store content files (see the abstract), a user interface allowing a user to make content selections (see Figure 5), a content database to manage relationships between content selections and the content files (see item 21 in Figure 4), a processor to perform at least one organization task on at least one of the content files based upon the content selection (see column 25, lines 6-47).

Regarding claims 2, 3, Rose discloses that the content files are music files and video files (see the abstract).

Regarding claim 4, Rose discloses a user interface including a display and control buttons (see Figure 5).

Regarding claim 5, Rose discloses a user interface comprising a display and alphanumeric keypad when Rose shows that the client computer is a personal computer with Window operating system (see column 25, lines 26-32).

Regarding claim 6, Rose discloses sorting the content files when Rose shows that the projects are indexed in the project table 80 (see column 7, lines 1-3).

Regarding claim 7, Roses discloses searching the content files (see Browser/Search in Figure 4).

Regarding claim 8, Rose discloses a method of updating content on a media device when Rose shows that the method stores checked-in multimedia assets (see the abstract). The claimed "receiving a user input signal to identify a selection of content files" is met when Rose shows the Browse/Search option. The claimed "accessing a database...content files" is met when Rose shows that the method allows users to obtain results to a search via the multimedia asset management program 22 (see Figure 2, lines 41-66). The claimed "connection of the player to a source of content" and "executing at least one predetermined rule...content files" are met when Rose shows that only users assigned to a project can check assets in and out of that project (see column 6, lines 60-65).

Regarding claim 9, Rose discloses that the source of content files is a media server (see the abstract).

Regarding claim 10, Rose discloses that the source of content files is a network when Rose shows that the content files are checked in and out by a plurality of users (see the abstract).

Regarding claim 11, Rose discloses adding at least one content file to the media player when Rose shows checked-in assets (see column 6, lines 60-65).

4. Claims 16-21, 23, 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Perkes (US 2003/0110503).

Regarding claim 16, Perkes discloses all the claimed subject matter (see the abstract, Figures 1, 4). The claimed "receiving a user input...content files" is met when Perkes shows that the method receives a user request for multimedia. The claimed "accessing a database...content files" is met when Perkes shows that the method searches for data requested. The claimed "determining if any content is not already existing on the media player, connecting the player to a source of content and adding any content files not already existing on the media player" are met by the fact that the method of Perkes allows users to purchase media objects (see 0228, 0229). Clearly the method has to determine if any content is not already existing on the media player and connect the player to a source of content before purchasing.

Regarding claim 17, Perkes further discloses sequentially transferring the content file to fill play lists (see 0058).

Regarding claim 18, Perkes further discloses the concept of transferring content across play lists (see 0289).

Regarding claim 19, Perkes discloses an article containing machine-readable code for a machine to receive a user input signal to identify a selection of content files (see Figure 13), access a database of content files (see 0228), connect the player to a source of content (see 0229). The claimed "execute predefined rules...selection of content files" is met by the fact that a user selects a media for purchasing. Clearly in the process, the machine has to execute predetermined rules as claimed.

Regarding claim 20, the claimed "add content files to the media player" is met when Perkes shows that a user purchases media objects (see 0229).

Regarding claim 21, Perkes discloses deleting a content file from the media player (see 0061).

Regarding claim 23, Perkes further discloses sequentially transferring the content file to fill play lists (see 0058).

Regarding claim 24, Perkes further discloses the concept of transferring content across play lists (see 0289).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose et al (US 5,752,244), in view of Perkes (US 2003/0110503).

Regarding claim 12, although Rose does not specifically show deleting at least one content file from the media player, it is well known in the art as shown by Perkes to delete a content file from the media player (see 0061). Therefore, it would have been obvious to one of ordinary skill in the art to include the claimed features while implementing the method of Rose in order to allow the users to remove unwanted files from the media player.

Regarding claim 13, although Rose and Perkes do not specifically show transferring the content file to the content source prior to deleting the content file from

the player, it would have been obvious to one of ordinary skill in the art to include such features in order to preserve a unique file.

Regarding claim 14, Perkes further discloses sequentially transferring the content file to fill play lists (see 0058).

Regarding claim 15, Perkes further discloses the concept of transferring content across play lists (see 0289).

6. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perkes (US 2003/0110503).

Regarding claim 22, although Perkes does not specifically show transferring the content file to the content source prior to deleting the content file from the player, it would have been obvious to one of ordinary skill in the art to include such features in order to preserve a unique file.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen T. Le whose telephone number is 703-305-4134. The examiner can normally be reached on M-F 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

6 July 2004


UYEN LE
PRIMARY EXAMINER